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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,072	11/03/2003	Lisa M. Becker	N0176US	3726

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NAVIGATION TECHNOLOGIES
222 MERCHANDISE MART
SUITE 900, PATENT DEPT.
CHICAGO, IL 60654

EXAMINER

TRAN, DALENA

ART UNIT PAPER NUMBER

3661

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,072

Applicant(s)

BECKER ET AL.

Examiner

Dalena Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 21-39 are pending.
2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 21, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 8 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 2 in U.S. Patent No. 6,671,615 read on claim 21 in 10/700072. Also, it is obvious that corresponding method claim 8 in U.S. Patent No. 6,671,615 (refer as '615) read

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on lines 2-5 of claim 21 in 10/700072, because claim 8 ('615), lines 13-19 read “ providing the user of said navigation system with the information about the roadside sign determined to be in the vicinity of the vehicle, wherein said information includes at least one of: commercial information, historical information and a translation of the text of the roadside sign into a language, other than the language of the roadside sign”.

Claim 22, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 3 in U.S. Patent No. 6,671,615 read on claim 22 in 10/700072.

Claim 23, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 9 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 9 in U.S. Patent No. 6,671,615 read on claim 23 in 10/700072.

Claim 24, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 11 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 11 in U.S. Patent No. 6,671,615 read on claim 24 in 10/700072.

Claim 25, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 26 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because subject matters of claim 26 in U.S. Patent No. 6,671,615 read on claim 25 in 10/700072.

Claim 26, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 28 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 28 in U.S. Patent No. 6,671,615 (refers as '615) read on claim 26 in 10/700072. It is obvious that claim 28 ('615) read on claim 26 of 10/700072 because, claim 28 reads "accepting a filter criterion from the user so that information about the roadside sign determined to be in the vicinity of the vehicle is provided to the user only if the filter criterion is satisfied", therefore it is obvious that associated information provided to the user meets a filter criterion.

Claim 27, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 29 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 29 in U.S. Patent No. 6,671,615 read on claim 27 in 10/700072.

Claim 28, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 3 of U.S. Patent No. 6,671,615 (refers as '615). Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claims 2 and 3 in U.S. Patent No. 6,671,615 read on claim 28 in 10/700072. It is obvious that a navigation system is a mobile computing platform, because navigation system ('615) comprising a database that includes data identifying locations of

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roadside signs, and a user interface that provides information about roadside sign to the user as in claim 28 (10/700072).

Claim 29, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 8 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 8 in U.S. Patent No. 6,671,615 read on claim 29 in 10/700072.

Claims 30, and 31, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 11 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 11 in U.S. Patent No. 6,671,615 read on claim 30 in 10/700072. It is obvious that user interface such as speaker, speech synthesis technology through which the driver can be provided with information from the navigation system can also be a display screen.

Claim 32, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 28 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 28 in U.S. Patent No. 6,671,615 read on claim 32 in 10/700072.

Claim 33, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 29 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct

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from each other because subject matters of claim 29 in U.S. Patent No. 6,671,615 read on claim 33 in 10/700072.

Claim 35, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claims 17, and 28 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claims 17 and 28 in U.S. Patent No. 6,671,615 (refers to '615) read on claim 35 in 10/700072. In claim 28 of ('615), reads "accepting a filter criterion from the user so that information about the roadside sign determined to be in the vicinity of the vehicle is provided to the user only if the filter criterion is satisfied; claim 28 is depend on claim 17, claim 17 reads in lines 10-11, providing the user with the commercial information about the roadside sign. Therefore, claims 17 and 28 of ('615) read on claim 35 in 10/700072.

Claim 36, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 1 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claim 1 in U.S. Patent No. 6,671,615 read on claim 36 in 10/700072.

Claim 37, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claims 1,17, and 28 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claims 1,17, and 28 in U.S. Patent No. 6,671,615 read on claim 37 in 10/700072. Claim 1 read in lines 8-9, "accepting a filter criterion from the user, wherein said filter criterion relates to a business chain"; claim 17, reads in lines 10-12,

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“providing the user of said navigation system with the commercial information about the roadside sign determined to be in the vicinity of the vehicle”; and claim 28 depend on claim 17, reads “accepting a filter criterion from the user so that information about the roadside sign determined to be in the vicinity of the vehicle is provided to the user only if the filter criterion is satisfied”. Therefore, it is obvious that claims 1, 17, and 28 in U.S. Patent No. 6,671,615 read on claim 37 in 10/700072 “the filtering criterion is a user specified preference”.

Claim 38, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 26 of U.S. Patent No. 6,671,615. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matters of claims 26 in U.S. Patent No. 6,671,615 read on claim 38 in 10/700072.

4. Claims 34, and 39, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding method claim 24 of U.S. Patent No. 6,671,615 in view of Kakiyama et al. (5,293,163).

As per claims 34, and 39, it is obvious that names of intersection (column 3, line 55 in ('163) reference), the locations and names of buildings (column 3, line 56), and traffic jam information (column 3, line 58); all these are related to road information and obvious road information can be posted by using a sign along a road to indicate to a driver. In ('163) reference, these information (names of intersection, the locations and names of buildings, and traffic jam information can be stored in vehicle or remotely located from an external source (column 3, lines 61-63). Therefore, it is obvious that database can be stored remotely for providing update information in case of there is a new location along the road.

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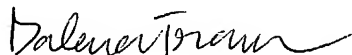
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dalena Tran whose telephone number is 703-308-8223. The examiner can normally be reached on M-F (7:30 AM-5:30 PM), off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner
Dalena Tran



May 10, 2004